

REMARKS

Claims 1 and 3-10 are pending in the present application, with claims 11-16 having been cancelled.

Interview of January 14, 2004

Applicants would like to thank the Examiner for his time during the very helpful interview of January 14, 2004, which was conducted with Applicants' representative. The Declaration of Mr. YASUDA, containing the additional experiments that were reviewed during the interview is attached hereto and further discussed below.

Claims 11-16

The Examiner indicated in both the Final Office Action and Interview he considers that claims 11-16 as being drawn to an independent invention from claims 1-10. Claims 11-16 therefore have been withdrawn. Claims 11-16 have been cancelled without prejudice or disclaimer of the subject matter contained therein.

Issues under 35 U.S.C. §§ 102(a) and 103

The Examiner maintains the rejection of claims 1, 3, 5, and 7-9 under 35 U.S.C. § 102(a)/103 as being anticipated by or obvious over EP '701. Claim 6 is free of this rejection. Claim 10 remains rejected under 35 U.S.C. § 103(a) as being obvious over EP '701

combined with WO 97/34196 (hereinafter referred to as "WO '196") and EP 021433 (hereinafter referred to as "EP '433"). Claims 4 and 6 remain rejected under 35 U.S.C. § 102(b)/103(a) as being anticipated by or obvious over EP '433 or WO '196.

In response to Applicants' arguments of July 28, 2003 and August 18, 2003 and the experiments of the second declaration of Mr. YASUDA, the Examiner asserts that the experiments and arguments were insufficient to overcome the rejections for the following reasons.

Reason A) The Examiner notes that the composition of organic silver salt A of EP '701 contains a mixture of silver behenate and silver stearate (made using behenic acid and stearic acid). The organic silver salt B of the Declaration, on the other hand, contains only silver behenate. The Examiner asserts that because of this difference in the silver salt compositions of EP '701 and the Declaration submitted August 18, 2003, it is not possible to conclude that the superior results reported in the Declaration are solely due to the use of a closed mixing means. In addition, the Examiner notes that the claims encompass silver salt grains containing a mixture of silver behenate and silver stearate.

Reason B) The Examiner further finds the Declaration to be insufficient because of the difference in the spectral sensitizing dyes used in the second Declaration experiments versus EP '701. The Examiner notes the statement by Mr. YASUDA that one skilled in

the art would not expect any effect on the results reported in the Declaration from the changed spectral sensitizing dye. However, the Examiner finds the statement by Mr. YASUDA to be unconvincing because no scientific explanation is given for why one skilled in the art would not expect any effect on the results of Declaration if the spectral sensitizing dye is different from that used in EP '701.

Reason C) Finally, the Examiner asserts that the difference for the values reported in the Declaration for haze, fog and sensitivity are all within the limit of the error range. As such, the results reported for a closed mixing means are not "unexpected."

Applicants traverse this rejection and withdrawal thereof is respectfully requested. As previously, noted the present invention is most broadly encompassed by claim 1, which recites a thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty acid silver salt grains wherein the non-photosensitive fatty acid silver salt grains are prepared by mixing and reacting a silver ion-containing solution, the solvent of which is water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which is water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means.

Thus, the present invention is drawn to a product, which is defined by the process by which it is made. Specifically, the product of the present invention requires the presence of non-photosensitive fatty acid silver salt grains that are prepared by mixing and reacting a silver ion-containing solution and a solution of a fatty acid alkali metal salt in a closed mixing means. With the present invention, the use of a closed mixing means results in a different and superior product than that of the prior art.

As noted above, the present claims specifically require that the product be made using a closed mixing means. EP '701 discloses the use of conventional methods, i.e. open mixing, for producing non-photosensitive fatty acid silver salt grains. By using the recited process of claim 1, the resulting product has unique properties compared to the product of EP '701.

As presented to the Examiner during the interview of January 14, 2004, attached hereto is an additional Declaration of Mr. YASUDA, submitted under 37 C.F.R. §1.132, wherein the unexpected advantageous properties associated with the invention are clearly demonstrated.

In the attached Declaration, Mr. YASUDA has conducted additional experiments wherein a composition of EP '701 made with an open mixing means (Sample No. 11, Dispersion A) was compared to the same composition with the exception that a closed mixing means was used (Sample No. 12, Dispersion B'). In addition, Applicants note

that Dispersion A and Dispersion B' both use Sensitizing A of EP '701. Thus the experiments of the attached Declaration compared the prior art preparation to a preparation of the invention with the only changed variable being the use of a closed mixing means with inventive Samples 12 and 13. As such, the experiments of the attached Declaration compare the closest prior art to the invention and are fully commensurate with the claimed invention and the new Declaration experiments of Mr. YASUDA address Reasons A and B discussed above, regarding the sufficiency of the comparative tests.

The experiments of the attached Declaration and the data presented therein, demonstrate that the product of the invention made with a closed mixing means is superior to a preparation made with an open mixing means in the properties of haze, sensitivity and surface property.

In Reason C discussed above, the Examiner found the previously submitted data insufficient with the assertion that the difference for the values reported in the second Declaration for haze, fog and sensitivity are all within the limit of the error range. As such, the results reported for a closed mixing means are not "unexpected."

As discussed during the interview, the property of Surface Property as presented in the attached Declaration, while reported as letter value of "C" for the comparative Sample No. 11 and "A" for inventive Sample Nos. 12 and 13, is determined as a

quantitative numerical value. Specifically, as detailed on page 2 of the Declaration, the Surface Property was evaluated as set forth on page 93 of the specification and only samples having 2 or less agglomerated specks per 1.4 m² are rated as "A". Thus, the Samples of the invention (Samples 12 and 13) show unexpected and significant advantageous properties over the Sample of the prior art. Applicants need only demonstrate a single unexpected advantageous property to show the unobviousness of an invention. As such, the improved Surface Property associated with invention establishes the unobviousness of the invention over EP '701.

However, the invention has additional unexpected improvements with the properties of haze and sensitivity. During the interview of January 14, 2004, the Examiner raised the question of the significance in a difference in the reported sensitivity value of 100 for composition of the prior art (Sample 11) compared to values of 106 or 107 for the inventive Samples 12 and 13, respectively. However, as indicated on page 4, final paragraph, spanning page 5 of the Declaration of Mr. YASUDA numerical differences in sensitivity, such as the differences in the sensitivity between the inventive Samples 12 and 13 and the comparative Sample 11, would be considered by one skilled in the art to be significant.

Finally, during the interview, the Examiner indicated that the Declaration must have an affirmative statement from the Declarant that states that one skilled in the art would find that the

improvements achieved with the invention are unexpected. The Examiner's attention is directed to page 4, 3rd paragraph of the Declaration, which explicitly states the conclusion by Mr. YASUDA that one skilled in the art would have no motivation to achieve the invention and that the invention possesses unexpected improvements over the prior art, such that one skilled in the art would find the invention unobvious.

As Applicants have clearly demonstrated the unexpected improved properties associated with the invention with experiments that are commensurate in scope with the invention and that compare the closest prior art. As such, withdrawal of the rejections and allowance of the claims is respectfully requested.

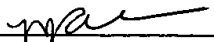
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: Declaration of Mr. YASUDA, executed January 16, 2004